

AMENDMENTS TO THE DRAWING:

The drawing figures 1 and 2 presented on pages 19 and 20 of the application were mislabeled "Appendix 1" and "Appendix 2". They are drawing figures that comprise flow charts. Accordingly proposed changes have been shown on replacement sheets accompanying this amendment. Approval and entry of the drawing changes in figures 1 and 2 is respectfully requested.

REMARKS

This amendment is in response to the non-final Office Action dated June 18, 2007.

I. NEW CLAIMS

New claims 13 to 24 have been added and the originally filed claims 1 to 12 have been canceled. New claims 13 to 24 include coated dye-containing pellet claims 13 to 19 and new method-of-preparation claims 20 to 24.

The coated dye-containing pellet independent claim 13, which includes subject matter from canceled claim 1, claims an encapsulated or coated dye-containing pellet comprising a dye-containing pellet and a coating material that coats the pellet. The basis for using the terms “encapsulating” and “coating” interchangeably appears in the second line of the fifth paragraph on page 1 and the first full paragraph (middle of the page) on page 3 of applicants’ originally filed specification. Also the term “coating” is used in the “Appendix 1”, which is now considered to be figure 1, since the arrows and boxes are best shown in a figure. The basis for the amount range for the oxidation dye precursor compounds is found in the fourth paragraph on page 5 of the originally filed specification.

The basis for dependent claim 14 is found in the fifth paragraph on page 5 of the originally filed specification.

The basis for new dependent claims 15, 16, 17, 18, and 19 is found in

canceled dependent claims 9, 3, 5, 6, and 8 respectively.

The new method claim 20 covers a method of preparing a colorant for keratin fibers and replaces the canceled “use” claim 12. The basis for claim 20 is found in canceled claim 1, in the sixth paragraph on page 1 of the applicants’ originally filed specification, in the last paragraph on page 9 of the applicants’ originally filed specification (last step of claim 20), and in third full paragraph on page 5 of the applicants’ originally filed specification (the amounts of the oxidation dye precursors).

Basis for claim 21 is found in the first full paragraph on page 9 of the applicants’ specification.

The subject matter of claims 22 and 23 is based on canceled claims 3 and 5 like claims 16 and 17.

Basis for claim 24 is found in the first paragraph on page 10 of the applicants’ originally filed specification.

II. CHANGES IN THE SPECIFICATION AND DRAWING

“Appendix” 1 and 2 presented on pages 19 and 20 of the originally filed application are figures because they show flow charts for the described methods of preparing the coated dye-containing pellets. These flow charts should be included in any issued patent based on the present application as figures in order to properly show their arrows and boxes.

For the forgoing reasons figures 1 and 2 have been amended to delete the

heading and label them as figures 1 and 2 respectively. Furthermore the specification on page 1 has been amended to change the term "Appendix" to "figure". Also a brief description of the drawing section has been added to page 1, which is required by U.S. Patent Office Rules.

In addition the standard section headings have been included in the specification, which are recommended according to Rule 77.

Entry of the changes in the specification and drawing is respectfully requested.

III. REJECTIONS UNDER 35 USC 112

Claims 12 was rejected under 35 U.S.C. 112, second paragraph, for appearing to claim a method or process without setting forth steps of positive actions that are performed in the course of the method.

Claim 12 was also rejected under 35 U.S.C. 101 because it is in a non-statutory form, namely it was a "use" claim.

Claim 12 has been canceled, obviating its rejection on these grounds. No new claims have been presented in a non-statutory form.

New claim 20 is a claim for a method of preparing a colorant using the coated dye-containing pellets. This new claim 20 replaces the canceled claim 12.

It is respectfully submitted that new claim 20 should not be rejected under 35 U.S.C. 112.

IV. DOUBLE PATENTING

Claims 1 to 12 were *provisionally* rejected on the ground of non-statutory obviousness-type double patenting (**ODP**) as obvious over claims 1 to 17 of copending U.S. Patent Application Ser. No. 11/705,626.

A properly signed terminal disclaimer accompanies this amendment, which disclaims that portion of the term of any patent that issues on the above-identified U.S. Patent application, which extends beyond the expiration date of any patent that issues from co-pending U.S. Patent Application Ser. No. 11/705,626.

It is respectfully submitted that new claims 13 to 24 should not be *provisionally* rejected on the ground of non-statutory obviousness-type double patenting (**ODP**) over claims 1 to 17 of copending U.S. Patent Application Ser. No. 11/705,626 because of the filing of the terminal disclaimer.

V. ANTICIPATION REJECTION

Claims 1 to 7 and 10 to 12 were rejected as anticipated under 35 U.S.C. 102 (b) by Satou, et al (US Patent 5,017,195).

Satou, et al, do disclose a coated dye-containing granulate comprising

dye-containing granular particles and a coating that coats the granular particles (see abstract, claim 1, column 1, lines 52 to 56).

However Satou, et al, discloses that the dye-containing granular particles contain only direct dyes and a carrier or binder (column 1, lines 60 to 65; examples in columns 3 and 4). The disclosure of Satou, et al, does not mention oxidation dye precursors or explain how their methods could be applied to oxidation dye precursors.

Claim 13 has been limited to a coated dye-containing pellet that contains oxidation dye precursors. Thus claim 13 avoids anticipation by Satou, et al, because Satou, et al, does not disclose or suggest a coated dye-containing pellet that contains oxidation dye precursor compounds. Examples of these compounds are of course provided in new claim 19, but the inventive concept should not be limited to particular oxidation dye precursor compounds.

Satou, et al, also discloses that their dye-containing granular particles are made by a wet granulation process comprising “adding 0 to 2 parts by weight of a binder and 20 to 40 parts by weight of water to 100 parts by weight of the above-mentioned dye” in column 2, lines 1 to 5, of US ‘195. Also in the case of example 1, 100 parts of dye are combined with only 5 parts of sodium alginate binder. The same is true of the other examples in columns 4 to 6 of US ‘195.

In contrast, claim 13 claims a coated dye-containing pellet comprising a dye-containing pellet, which contains from 0.1 to 70 percent by weight of at least one oxidative dye precursor. Thus the dye-containing pellet of claim 13 must contain at least 30 percent by weight of the carrier material. For this additional

reason claim 13 also avoids anticipation by Satou, et al.

It is well established that each and every limitation of a claimed invention must be disclosed in a single prior art reference in order to be able to reject the claimed invention under 35 U.S.C. 102 (b) based on the disclosures in the single prior art reference. See M.P.E.P. 2131 and also the opinion in *In re Bond*, 15 U.S.P.Q. 2nd 1566 (Fed. Cir. 1990).

In summary, Satou, et al, does not anticipate new claim 13 because Satou, et al, do not disclose a coated dye-containing granulate or pellet, in which

(1) the pellet or granulate includes at least 30 % by weight of a carrier material or a binder; and

(2) the pellet or granulate includes oxidation dye precursor compounds.

The analysis with respect to method claim 20 is similar. Method claim 20 is a claim for a method of preparation of the coated dye-containing pellet of claim 13. Satou, et al, does not anticipate method claim 20, because Satou, et al, does not disclose the step of uniformly mixing oxidation dye precursor compounds with a carrier material. Also Satou, et al, does not disclose mixing at least 30 percent by weight of the binder or carrier material with the oxidation dye precursor compounds.

For the foregoing reasons and because of the new limitations in the new claims 13 to 24, it is respectfully submitted that **none** of the new claims 13 to 24 should be rejected as anticipated under 35 U.S.C. 102 (b) by Satou, et al (US

Patent 5,017,195).

VI. OBVIOUSNESS REJECTION

1. Satou, et al, Alone

It is respectfully submitted that none of the new claims 13 to 24 should be rejected as obvious under 35 U.S.C. 103 (a) over Satou, et al (US Patent 5,017,195).

First, Satou, et al, does not disclose or suggest a coated dye-containing pellet containing oxidation dye precursor compounds, i.e. developers and couplers. These latter types of dye compounds are not even mentioned at all in Satou, et al.

It is well established that reasons for an obviousness rejection must include an explanation of the motivation that one skilled in the art would have to modify the disclosures in a prior art reference or references to obtain a claimed invention. For example, the Federal Circuit Court of Appeals has said:

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification... It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 U.S.P.Q. 2nd 1780, 1783-84 (Fed. Cir. 1992).

If Satou, et al, includes a suggestion to replace the direct dyes in their

dye-containing granulate with oxidation pre-cursor dyes, its location in US '195 should be pointed out and appropriate reasons should be provided. Other prior art of record suggests that only direct dye granulates or particulates should be coated or encapsulated. Toumi, et al, which is also of record, suggests that only direct dye-containing granulates or particulates should be coated or encapsulated and only when a reducing agent is present in the composition or only when oxidation dye precursors and reducing agents stabilizing the oxidation dye precursors are present in the composition. Toumi, et al, and its relevance will be discussed in more detail herein below.

Second, Satou, et al, alone contains teaching of doing the opposite from the claimed invention in new claims 13 to 24. Claims 13 and 20 each require at least 30 % by weight of the carrier or binder in the dye-containing pellet or granulate. Satou, et al, limits the amount of binder to only a few percent according to column 2, lines 1 to 6, of US '195. This amounts to teach of doing the opposite from the subject matter of claims 13 to 24.

It is well established that a prior art reference that contains teaching of doing the opposite from the claimed invention cannot be used to reject a claimed invention under 35 U.S.C. 103 (a). For example, see M.P.E.P. 2145 X. Also the Federal Circuit Court of Appeals has said:

“In determining whether such a suggestion [of obviousness] can fairly be gleaned from the prior art...It is indeed pertinent that these references teach against the present invention. Evidence that supports, rather than negates, patentability must be fairly considered.” ***In re Dow Chemical Co.***, 837 F.2nd 469,473, 5 U.S.P.Q.2d 1529, 1532 (Fed. Cir. 1988)

For the foregoing reasons it is respectfully submitted that none of the new claims 13 to 24 should be rejected under 35 U.S.C. 103 (a) over Satou, et al, alone.

2. Satou, et al, in view of Toumi, et al

Claim 8 was rejected under 35 U.S.C. 103 (a) as obvious over Satou, et al, in view of Toumi, et al.

New dependent claim 19 contains the features of canceled dependent claim 8.

Contrary to the opinion on page 5 of the Office Action Toumi, et al, does **not** disclose or suggest coated or encapsulated dye-containing pellets or granules of oxidation dye precursors. Toumi, et al, only discloses or suggests coated or encapsulated dye-containing pellets or granules of direct dyes.

For example, paragraph [0093] on page 5 of Toumi, et al, teaches a preferred embodiment comprising a multi-component kit for oxidative dyeing of the hair, in which component A contains

“in a cosmetic carrier, one or more oxidation dye precursors, a reducing agent and an aromatic dye, which is preferably water-soluble and which can be degraded by the reducing agent, **this dye** being enclosed in particles of a synthetic polymer containing aryl groupsand comprising S-S bonds and/or Si-phenyl bonds”,

and a component B containing hydrogen peroxide. The term “this dye” in the above quote refers only to the aromatic dye (i.e. the direct dye), not the oxidation dye precursors. This is the only interpretation of this paragraph that is consistent

with the earlier background section and “summary of the invention” section on pages 1 and 2 of the specification of US ‘077. Paragraphs [0005] to [0008] of US ‘077 in the background section explain that the purpose of the encapsulation of the direct dyes when they are included in dye compositions containing oxidation dye precursor compounds is to protect them from reducing agents that are included to stabilize the oxidation dye precursor compounds prior to use of the dye composition.

Thus US ‘077 then only discloses or suggests encapsulating or coating direct dye-containing particles, granules or pellets and only in the presence of oxidation dye precursors and stabilizing agents consisting of reducing agents. There is **no** suggestion that the oxidation dye precursors should be similarly contained in a dye-containing pellet or granule that can be ascertained in connection with [0093] of US ‘077.

Examples 1 and 2 and page 6, paragraph [0113], similarly do **not** teach or suggest a coated or encapsulated dye-containing pellet or granule that contains oxidation dye precursors. The paragraph [0113] does state that the oxidation dye precursors (bases and couplers) could be included in compartment or component A of the kit, but does not state that they should be encapsulated or coated in the matrix comprising the synthetic polymer with aryl groups of US ‘077. All that paragraph [0113] teaches is that oxidation dye precursors can be included in component A of paragraph [0105], not that they too can or should be encapsulated in the matrix. In fact, such encapsulation of the oxidation dye precursors would be counter to the reason for encapsulating the direct dye

compounds because the direct dyes are encapsulated in the polymer matrix to allow time for the oxidation dye precursors to react with the preferred hydrogen peroxide and thus to start the dyeing process prior to releasing the entire amount of the direct dye from the synthetic polymer matrix, since it would otherwise react with the stabilizing agent that is present at the start of the oxidation dyeing process (see paragraph [0007] of US '077).

The example disclosed in paragraph [0105] only discloses a kit that has a component A that includes an encapsulated or coated direct dye-containing particulate or granulate, a base, a reducing agent -- namely sodium metabisulfate, and water and a component B that includes hydrogen peroxide. The hydrogen peroxide is necessary to react with the synthetic polymer matrix to release the direct dye. Without the hydrogen peroxide the direct dye would not be released because the encapsulation matrix is not water-soluble! Thus example 2 of US '077 is for the purpose of demonstrating the release of the direct dye from the synthetic polymer matrix (see the results in [0110] - [0112]). Paragraph [0113] explains that oxidation dye compounds could be included in component A of example 2 for permanent dyeing of the keratin fibers but does not suggest that they should be encapsulated.

With respect to applicants' new dependent claims 17 and 23 US '077 clearly teaches against or the opposite from the water-soluble or water-dispersible coating or encapsulating materials of claims 17 and 23. Also note that applicants' specification states that water-soluble or water-dispersible film-forming substances are suitable as the encapsulating or coating agents in the

middle paragraph on page 3 of applicants' specification. US '077 clearly teaches that the solution described in paragraphs [0011] to [0017] of US '077, in which direct dyes are incorporated in an insoluble synthetic polymer matrix (containing aryl groups) that only releases the direct dyes when it reacts with a bond cleaving agent (e.g. hydrogen peroxide), is superior to other prior art solutions. This sort of encapsulating agent comprising a water-insoluble synthetic polymer matrix is the opposite from a water-soluble or water-dispersible polymer or coating agent. As noted above, a reference that teaches the opposite from a claimed invention cannot be used under 35 U.S.C. 103 (a) with or without another prior art reference to reject a claimed invention. M.P.E.P. 2145 X.

Thus Toumi, et al, together with Satou, et al, does not establish a case of *prima facie* obviousness of an oxidation dye precursor-containing granulate or pellets, which is coated or encapsulated with a water-soluble or water-dispersible coating material.

For the foregoing reasons it is respectfully submitted that **none** of the new claims 18 to 24 should be rejected under 35 U.S.C. 103 (a) over Satou, et al, in view of Toumi, et al.

3. Satou, et al, in view of Miczewski, et al

Claim 9 was rejected under 35 U.S.C. 103 (a) as obvious over Satou, et al, in view of Miczewski, et al, US Patent Application 2004/0045101 A1.

New dependent claim 15 replaces the canceled dependent claim 9, which does claim the pellet including preferred oxidation dye precursor compounds.

Miczewski, et al, teach a semi-permanent hair color composition for touching up gray hairs between oxidative dyeing procedures according to paragraphs [0006] to [0016] and claims 1 and 2. The term “semi-permanent” is explained in paragraph [0003], which clearly limits the semi-permanent composition to containing direct dyes because it indicates that semi-permanent dyes are single component products (would not include a separate oxidizing agent component). Miczewski, et al, do not disclose any dye compositions containing oxidation dye precursor compounds or even mention oxidation dye precursor compounds.

Thus Miczewski, et al, do **not** teach or suggest anything regarding encapsulating or coating an oxidation dye precursor-containing granulate or pellets, which comprises a carrier material and an oxidation dye precursor compound in the amount claimed in applicants’ new independent claim 13.

Thus Miczewski, et al, cannot supply the hint or suggest required under 35 U.S.C. 103 (a) to modify the disclosures of Satou, et al, to arrive at the invention as claimed in applicants’ new claim 13. Miczewski, et al, like Satou, et al, only teaches dye compositions containing direct dyes. Miczewski, et al, does not suggest modification of the disclosures of Satou, et al, to arrive at the encapsulated or coated oxidation dye precursor containing pellets of applicants’ new claim 13 with the claimed amounts of carrier and dye compounds.

Furthermore US ‘101 discloses liquid dye compositions containing polar solve and association structures in which direct dyes are included. The term “association structures” means micelles or liquid crystals according to paragraph

[0040]. The association structures are formed by interaction of a surfactant with the polar solvent according to paragraph [0040].

The coating of solid pellets containing oxidation dye precursors is completely unrelated to the liquid dye compositions with association structures containing direct dyes of US '101. US '101 cannot suggest anything related to the subject matter of claims 13 to 24.

Furthermore the reason US '101 was cited is based on the disclosure of a dye composition comprising association structures containing a particular direct dye, Basic Brown 17, which is one of the exemplary dyes recited in applicants' dependent claim 15. However one skilled in the art would find no motivation from US '101 to include the Basic Brown 17 in the oxidation dye precursor containing pellets of applicants' claimed composition of claim 13 because the purposes and objects of the two prior art references are entirely different and because the liquid dye compositions of US '101 are entirely different and unrelated to the solid compositions of the applicants.

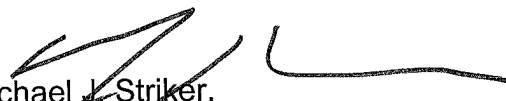
Miczewski, et al, does not suggest anything more for the applicants' claimed compositions than an encyclopedia or handbook that lists various direct dye compounds including Basic Brown 17.

For the foregoing reasons it is respectfully submitted that **none** of the new claims 18 to 24 should be rejected under 35 U.S.C. 103 (a) over Satou, et al, in view of Miczewski, et al.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,


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